

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claim 1 is currently amended. Applicant requests that the examiner enter the submitted claim amendment because no new matter is being added. Moreover, the amendment will require no further searching or burden on the examiner.

Additionally, new claims 16-24 are being added to the application. Support for these new claims can be found in the example peptides described throughout the specification. Additionally, the subject matter of these new claims is narrower in scope than the previously submitted claims and therefore, the search that the examiner conducted on the broad subject matter covered by the previously submitted claims should also encompass the subject matter of the more narrow, newly submitted claims. Accordingly, applicant requests that the examiner enter and consider these new claims because no new matter has been added and no additional search is required. Upon entry of the present amendment, claims 1 and 3-24 will be pending.

**Claim Objections**

The examiner objected to claims 5-8 and 12 for depending from a rejected base claim, but found that they would be allowable if written independently. Claims 8 and 12, however, already are independent claims. Since claim 1 is allowable, moreover, for the reasons discussed below, applicants have not amended claims 5 and 6.

**Rejection Under 35 USC § 102(b)**

The examiner has rejected claims 1, 3-4, 6, and 13 as being anticipated by Grey et al. Applicant respectfully disagrees.

The crux of the examiner's rejection rests on the alleged "intended use" limitation that he believes is present in claim 1, *i.e.*, "a peptide that inhibits T-cell antigen receptor (TCR)

function.” Claim 1 does not possess such a limitation, however. Rather, claim 1 qualifies the *structure* of subject peptides, in functional and chemical-formulaic terms, respectively.

That is, in making this rejection, the examiner mistakenly alleges that the ability of a claimed peptide to inhibit T-cell receptor function is not structurally related and, hence, that it embodies an “intended use” for the claimed peptides. Yet, the property of inhibiting TCR function is quintessentially structural in its connotation.

Effective receptor inhibition, as recited, requires that a peptide fit the receptor site or, via binding, interfere with the receptor subunit assembly. The ability to block the receptor subunit assembly or the receptor site itself requires a peptide, thus qualified, possess a specific structure. In other words, a *structural* aspect that characterizes the claimed peptides is identified by an ability to inhibit TCR function.

That the claim language in question does more than simply state an intended use is apparent from the fact that the language excludes the peptides taught by Grey, which, by virtue of their structure, actually elicit rather than inhibit a T-cell response. Therefore, contrary to the peptides claimed in the present invention, the Grey peptides do not possess the necessary structure to allow them to inhibit T-cell receptor function. Accordingly, the Grey peptides do not anticipate the peptides of the present invention.

Finally, applicant submits new claims 16-24, which cover peptides that inhibit TCR function, but which also cover peptides “where X<sub>1</sub> is an amino acid selected from the group consisting of alanine, isoleucine, leucine, valine, glycine, methionine, threonine, phenylalanine, tryptophan and serine, and X<sub>2</sub> is an amino acid selected from the group consisting of glycine, alanine, valine, leucine, isoleucine, threonine, methionine, glutamine, and cysteine.” In contrast, the Grey peptides have a cysteine and/or tyrosine amino acid in the X<sub>1</sub> position and a serine, tyrosine and/or praline amino acid in the X<sub>2</sub> position. Accordingly, the Grey peptides do not anticipate claims 16-24, because, first, they do not possess the necessary structure to allow them to inhibit T-cell receptor function and second, because they do not possess the necessary amino acids to satisfy the claimed formula. Therefore, because

the Grey peptides do not anticipate the peptides covered by claim 1 or new claims 16-24, the applicant requests that the examiner withdraw this rejection and allow the present claims.

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

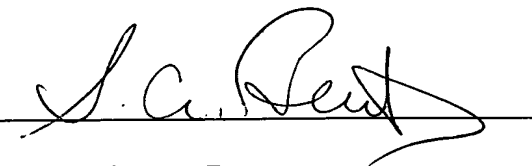
The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 15 February 2005

FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5404  
Facsimile: (202) 672-5399

By 

Stephen A. Bent  
Attorney for Applicant  
Registration No. 29,768